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MICHAEL CHAN
NCR CORPORATION
1700 SOUTH PATTERSON BLVD
DAYTON, OH 45479-0001

EXAMINER

MCCLELLAN, JAMES S

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3627

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/992,363
Filing Date: November 16, 2001
Appellant(s): DE SOUZA ET AL.

Gregory A. Welte
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 12, 2004.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 11, 14, 19, 22, and 24 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

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6,513,015 B2	Ogasawara	1-2003
5,903,880	Biffar	5-1999

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

- A.) Claims 9, 10, 22, 23, and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application No. US 2003/0078864 A1 (hereinafter "Hardesty").
- B.) Claims 1-8, 11, 13-21, 24, 26, and 29-31 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,513,015 (hereinafter "Ogasawara") in view of Hardesty.

The Examiner notes that the final office action includes a typographical error regarding the 35 U.S.C. § 103 rejection of claims 1-8, 11, 13-21, 24, 26, and 29-31. Hardesty was erroneously missing from the rejection statement. However, the body of the rejection clearly sets forth that Hardesty is the secondary reference. Additionally, paragraph 8 (p. 6) of the final office action refers to the 35 U.S.C. § 103 rejection of claims 1-8, 11, 13-21, 24, 26, and 29-31. On page 3 of the Appeal Brief, Appellant notes that the rejection statement in the final office is not complete. Appellant states that the rejection statement solely lists "Hardesty". As set forth above, the rejection statement mentioned "Ogasawara" but erroneously left out "Hardesty". Based on page 3 of the Appeal Brief, it appears that Appellant argues the 35 U.S.C. § 103 rejection of claims 1-8, 11, 13-21, 24, 26, and 29-31 as the rejection was intended by the Examiner.

- C.) Claims 12, 25, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogasawara in view of Hardesty as applied to claims 1-8, 11, 13-21, 24, 26, and 29-31 above, and further in view of U.S. Patent No. 5,903,880 (hereinafter "Biffar").
- D.) It is noted that the previous 35 U.S.C. § 101 rejection of claims 9 and 10 is withdrawn based on the point that the Examiner's broadest reasonable interpretation of the term "portal", wherein "portal" is defined by the *Microsoft Computer Dictionary*, 4th ed. as: A web site that

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serves as a gateway to the Internet; portal is a collection of links, content, and services designed to guide users to information they are likely to find interesting. Since the term “portal” (as defined above) places claim 9 clearly within the technological arts, the 35 U.S.C. § 101 rejection is withdrawn.

(11) *Response to Argument*

It is noted that Appellant repeated various arguments throughout the Appeal Brief. The Examiner replied to each main argument at least once in this ***Response to Argument*** but merely noted all other redundant occurrences of the same or very similar arguments at the beginning of each response. In no way did the Examiner intend to neglect to respond to the additional recitations of similar arguments. It is the Examiner’s position that each and every point, problem, or sub-point argued by Appellant is clearly addressed by at least one response.

On page 4, under **Faulty Reference** (also argued on page 10, under Problem 1), Appellant argues that Hardesty is not prior art. Appellant argues that Hardesty was “published” after the filing date of Appellant’s filing date. However, the Examiner notes that Hardesty’s filing date of 12/22/00 predates Appellant’s filing date of 11/16/01. Therefore, Hardesty is a valid reference and considered prior art.

On page 5, under Problem 1 (also argued on page 11, under Problem 3; page 13, under Problem 4; page 18, under Point 2; page 19, under Point 3; page 19, under Point 4; page 32, under Point 3), Appellant argues that the examiner’s definition of the term “portal” is a fanciful interpretation of term. The Examiner respectfully disagrees. In the art of electronic data processing, the term “portal” is defined as set forth above in section (10), paragraph (D):

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A web site that serves as a gateway to the Internet; portal is a collection of links, content, and services designed to guide users to information they are likely to find interesting (*Microsoft Computer Dictionary*, 4th ed.).

Absent an express definition by in specification, the Examiner may read the claim limitations as broadly as reasonably possible. On page 7, first paragraph of the specification, Appellant provides examples of portals (i.e. a door) but failed to provide a clear definition. Since examples are not considered an express definition, the Examiner defined “portal” as broadly as reasonably possible. In addition, Appellant recites language in other independent claims (i.e., claims 1 and 6) that clearly identifies a portal in the physical environment (“a portal to an enclosure”), as opposed to an electronic environment. It is the Examiner’s position that Appellant had ample opportunity to present claim language (claims 9, 10, 22, 23, and 28) in such as a manner that unquestionably defined “portal” in a physical environment (i.e., a door, gate, window, etc.). Since Appellant insisted on broad claim language, the Examiner maintained a broad interpretation of the term “portal”. Therefore, it is the Examiner’s position that the term “portal” as interpreted in an Internet shopping environment, as opposed to a brick and mortar shopping environment, is not an improper interpretation of the term.

On page 6, under Problem 2 (also argued page 10, under Problem 2; page 18 under Point 1; page 22, under Claim 28; page 26, under Point 1; page 27, under Point 2; page 39, under Claim Elements not Shown in Prior Art), Appellant argues that Hardesty does not award loyalty points for visiting web sites. It is Appellant’s position that loyalty points are awarded only for after making a purchase, which would be an incentive for a customer to revisit Internet store in the future. The Examiner respectfully disagrees. Hardesty clearly sets forth in paragraph 0007

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that loyalty points are awarded for either making a purchase or to “visit” web sites. Additionally, Hardesty notes in paragraphs 0030 and 0077 that users may be rewarded with non-spending activities (i.e., “directed web surfing”, wherein web surfing includes visiting online stores). A complete and thorough reading of Hardesty leaves zero doubt that Hardesty grants reward benefits for merely visiting an online store as opposed to most other businesses that require a customer to make a purchase (see paragraphs 0007, 0030, and 0077).

On pages 6-7, under Problem 1 (also argued on page 35, under Problem 1; page 40, under No Teaching Given; page 41, under No Compliance with Dembiczak), Appellant argues that there is no motivation to combine the references. In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner supplied ample motivation for combining Ogasawara and Hardesty in the final office action:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ogasawara with a response to the identify signal as taught by Hardesty, because providing an incentive for a customer to merely “visit” or enter the store attracts customers to the store, wherein inherently increasing the likelihood that the person will make a purchase (Final Office Action 5/3/04).

Appellant argues that the Examiner's motivation is merely an invocation of basic marketing principles. The Examiner agrees. It is noted that Ogasawara discloses awarding loyalty points to

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customers for making a purchase. Hardesty is merely relied upon to teach that it is old and well known to award loyalty points for simply visiting a store without necessarily making a purchase. Customer's are more likely to visit a store and potentially make a purchase if the customer is rewarded for visiting the store. Therefore, the Examiner's motivation is proper and would have been obvious to one of ordinary skill in the art at the time the invention was made because the motivation is a "basic principle of marketing".

On page 7, under Problem 2, Appellant argues that "most claims" state that bonus points are awarded in absence of a transaction (or similar), which is directly contrary to both references. First, it is unclear what claims Appellant is arguing. Secondly, Hardesty discloses awarding bonus points for merely visiting a store (see Hardesty paragraphs 0007, 0030, and 0077 as set forth above in detail).

On page 8, under Problem 3 (also argued on page 37, under **Claim 14**; page 38, under **Claim 19**; page 38, under **Claim 22**; page 39, under **Claim 24**), Appellant argues that the rejection of claims 14-26 fails to provide corresponding structure to meet the "means-type" recitation. The Examiner respectfully disagrees. As forth in the final office action (5/3/04) all limitations "means-type" limitations are clearly disclosed by Ogasawara. As an example, Ogasawara discloses means for detecting entry of a person through a portal (see Ogasawara, see paragraph bridging columns 8-9).

On page 14, under Problem 5, Appellant argues that a "web site" has no specific geographic locus. The claims fail to require a "specific geographic location". Appellant is arguing limitations not found in the claims. Therefore, Appellant's argument is moot.

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On page 15, under Problem 6, Appellant argues that Hardesty use of the term “visit” is placed in quotes because it is a fanciful use of the term. The Examiner respectfully disagrees. In an electronic environment, the use of term visit as related to a web site is a valid and well established use of the term.

On page 15, under Additional Point 1, Appellant argues that patent claims must be given the broadest reasonable interpretation **consistent with the specification**. As set forth above, the specification failed to set forth an express definition for the term “portal”. “Absent an express definition in their specification, the fact that appellants can point to definitions or usages that conform to their interpretation does not make the PTO’s definition unreasonable when the PTO can point to other sources that support its interpretation.” *In re Morris*, 127, F3.d at 1056, 44 USPQ2d at 1029. In this case the Examiner relies upon *Microsoft Computer Dictionary*, 4th ed., wherein a “portal” is a web site that serves as a gateway to the Internet; portal is a collection of links, content, and services designed to guide users to information they are likely to find interesting. Since the term “portal” (as defined above) places the claim 9 clearly within the technological arts, the 35 U.S.C. § 101 rejection is withdrawn.

On page 16, under Additional Point 2, Appellant argues that visiting a web site does not anticipate the claims. The Examiner respectfully disagrees. As set forth above, the Examiner is reading the claims as broadly as reasonably possible. As set forth above, Hardesty anticipates claims 9, 10, 22, 23, and 28.

On page 17, under Additional Point 3, Appellant acknowledges that the term “portal” has an additional definition that means “an entry point into a computer network.” As set forth above, the specification failed to set forth an express definition for the term “portal”.

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On page 17, under Additional Point 4 (also argue on page 32, under Point 4), Appellant argues that a website does not identify a person when the person visits the web site, except when persons identify themselves to the web site. It is the Examiner's position that when a person enrolls in the loyalty program of Hardesty, they are identifying themselves to the website. Therefore, Hardesty discloses identifying a person entering the online store through the web portal based on a persons loyalty program enrollment information.

On page 21, under Claim 22 (also argued on page 36, under **Claim 24**), Appellant argues that apparatus claim 22 is considered separately patentable from method claim 9 as PTO's restriction attests. It is noted that claims 9 and 22 were not restricted. Claims 9 and 22 are neither independent nor distinct in terms of restriction practice (same for claims 11 and 24).

On page 24, second paragraph, Appellant notes that Ogasawara does not alter the demographic profile, or add bonus points, when a customer is detected as entering the retail store. The Examiner agrees. However, Hardesty, not Ogasawara, is relied upon to teach altering the demographic profile, or add bonus points, when a customer is detected as entering a store.

On page 28, under Point 3 (also argued on page 28, under Sub-Point 3A; page 29, under Sub-Point 3B), Appellant argues that PTO must show a reasonable expectation of success. The Examiner agrees. Regarding 35 U.S.C. § 103 rejections, Ogasawara discloses detecting and identifying a person entering a store (see paragraph bridging columns 8-9). Additionally, Ogasawara discloses awarding loyalty points for a user's specific activity (in this case Ogasawara awards points for making purchases; see column 13, lines 38-55). Hardesty teaches awarding loyalty points for two specific user activities: making a purchase or visiting an online store (see paragraph 0007; see also paragraphs 0030 and 0077). Therefore, there is a reasonable

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expectation of success for Hardesty to teach Ogasawara the feature of awarding points to persons visiting a store (online or offline stores).

On page 30, under Point 1 (also argued on page 36, under Problem 2; page 36, under **Claim 24**), Appellant argues that the Examiner failed to establish *prima facie* case of obviousness because the Examiner did point to specific citations in the references for claims 11 and 13. Appellant's argument is noted but has little merit considering that all limitations of claims 11 and 13 were addressed in the same section but for different claims with similar limitations. For example, the Examiner detailed all features of claims 1-8 (see final office action, 5/3/04). For the sake of efficiency, the Examiner did not find it necessary to be redundant in the detailed explanation of the prior art references. All limitations of claims 11 and 13 are taught by Ogasawara and Hardesty as set forth in section 7 of the final office action (5/3/04).

On page 31, under Point 2 (also argued on page 36, under Problem 2; page 36, under **Claim 24**), Appellant requests clarification of where the prior art references a "transponder associated with a person", "identity signal", "portal", and an "enclosure". As set forth in the previous paragraph, the Examiner did not find it necessary to repeat limitations explained in detail for similar claims 1 and 6. Ogasawa discloses a transponder (11), an identity signal (via sensor processor 18), a portal (see Figure 1) and an enclosure (see paragraph bridging columns 8-9, line 56, "establishment"). Additionally, on page 31, Appellant notes that in Appellant's previous amendment (1/6/04), Appellant requested clarification of where Hardesty recites a transponder. As set forth in the final office action (5/3/04) mailed in response to Appellant's previous amendment (1/6/04), the Examiner relies upon Ogasawara, not Hardesty to disclose a transponder (see final Office Action, section 7, 5/3/04).

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On page 33, under Point 5 (also argued on page 33, under Point 6; page 33, under Point 7), Appellant argues that paragraph 0046 of Hardesty fails to teach the features of claim 11 (part b). In addition to paragraph 0046, Hardesty teaches transmitting a message to a location which is accessible by the person in response to the identify signal (see paragraph 0037 and 0038 that discuss transmitting a message concerning changes in user account based upon the identify signal).

On page 42, Appellant argues that no valid teaching has been given for combining Ogasawara, Hardesty, and Biffar. The Examiner respectfully disagrees. As set forth in the final office action on 5/3/04 the following motivation was submitted:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ogasawara with e-mail notification of loyalty information, because e-mailing account information will allow users to keep track of potential awards or incentives.

The motivation set forth above is proper because it provides a valid reason for one of ordinary skill in the art to incorporate the features of Biffar with the combination of Ogasawara/Hardesty. However, after a more detailed review of Hardesty, it is believed that Hardesty also teaches the features relied upon by Biffar (i.e., e-mailing incentive or loyalty point information; see Hardesty paragraphs 0037 and 0038).

Appellant's arguments related the 35 U.S.C. § 101 rejection are noted but are not persuasive on their own. However, the 35 U.S.C. § 101 rejections are withdrawn based on different reasons as set forth above in section **(10) Grounds of Rejection** (part D):

It is noted that the previous 35 U.S.C. § 101 rejection of claims 9 and 10 is withdrawn based on the point that the Examiner's broadest reasonable interpretation of the term "portal", wherein

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“portal” is defined by the *Microsoft Computer Dictionary*, 4th ed. as: A web site that serves as a gateway to the Internet; portal is a collection of links, content, and services designed to guide users to information they are likely to find interesting. Since the term “portal” (as defined above) places claim 9 clearly within the technological arts, the 35 U.S.C. § 101 rejection is withdrawn.

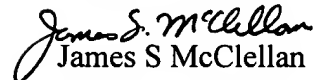
If it is determined that the term “portal” can not be read using the technical *Microsoft Computer Dictionary*, 4th ed. definition cited above, the 35 U.S.C. § 101 rejection will be reinstated for reasons set forth in the final office action (5/3/04). If “portal” is not give an technical definition, then it fails to meet the requirements of 35 U.S.C. § 101. At this point in time, the Examiner relies upon the technical definition of “portal” in the prior art rejection of claims 9, 10, 22, 23, and 28, and therefore can not currently maintain the 35 U.S.C. § 101 rejection of claims 9 and 10 for lack of technology in the claims. Once again, if the term “portal” is held to be non-technical (i.e., an opening, a door, etc.), then the 35 U.S.C. § 101 rejection will be reinstated.

On page 44, under Point 2, Appellant argues that Hardesty has been “issued” and should have been objected to like Appellant’s claims related to 35 U.S.C. § 101. Appellant is reminded that Hardesty is a published patent application, not an issued patent.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,



James S McClellan
Primary Examiner
Art Unit 3627

jsm

December 22, 2004

Conferees

R. Zeender 

T. Hafiz 

MICHAEL CHAN
NCR CORPORATION
1700 SOUTH PATTERSON BLVD
DAYTON, OH 45479-0001